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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/001,389 | 10/23/2001 | Charles K. Wike JR. | 9423 | 1315 |

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| EXAMINER | |
|---|---|
| LE, UYEN CHAU N | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2876 | |

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/001,389 | WIKE ET AL. | |
| | Examiner | Art Unit | |
| | Uyen-Chau N. Le | 2876 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *30 November 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *09/13/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *BPAI Decision*

1. In light of the BPAI decision, see pages 6-7 of the BPAI decision filed 30 November 2005, with respect to the rejection(s)of claim(s) 1-20 under 35USC 103 rejection, the examiner withdraws the previous rejection. However, upon further consideration, a new ground(s) of rejection is made in view of the newly cited references to Bellis, Jr. et al and Latimer et al.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before

November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-2, 4 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Bellis, Jr. et al (US 6,598,791).

Re claims 1 and 8: Bellis, Jr. et al discloses a self-checkout system comprises a barcode scanner 120 allowing consumer to scan an item for purchase (fig. 1; col. 3, lines 12+); a bagging station 270 includes one or more electronic article surveillance (EAS) monitors 300 for detecting the presence of active EAS tags among the items on the bagging station (i.e., because the EAS monitors 300 are disposed at the bagging station, it is inherently that an item being checked for an active EAS tag after the item being scanned) (fig. 1; col. 3, lines 37-51); allowing deactivation of the active electronic article surveillance tag by the consumer via an active electronic article surveillance tag deactivator after determining that the item has an electronic article surveillance tag (col. 9, lines 12-24).

Re claim 2: wherein the step of determining whether the item has an active electronic article surveillance tag includes utilizing the electronic article surveillance detector (i.e., EAS monitors 300) (fig. 1).

Re claim 4: further comprises a step of determining whether the electronic article surveillance tag has been deactivated after the step of allowing deactivation of the active electronic article surveillance tag after determining that the item includes the electronic article surveillance tag (i.e., via EAS monitors 300).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and

potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-12 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Latimer et al (US 6,857,567) in view of Bellis, Jr. et al. The teachings of Bellis, Jr. et al have been discussed above.

Re claims 1-12: Latimer et al discloses a checkout system comprises a scanner 40 allowing an operator to scan an item for purchase; a deactivation equipment is in very close proximity to or integrated with the scanner 40 and is triggered by a "good read" (i.e., successfully scan) signal from the scanner 40 (col. 3, lines 14-25), wherein the deactivation equipment includes a sensing antenna for determining if an active electronic article surveillance tag is present (col. 4, lines 24+); allowing the operator to deactivate the EAS tag via the EAS equipment after determining that the item has and EAS tag (col. 4, lines 8-16). Latimer et al further discloses a step of determining whether the electronic article surveillance tag has been deactivated after the step of allowing deactivation of the active electronic article surveillance tag after determining that the item includes the electronic article surveillance tag (i.e., allowing the operator to pass the scanned items back across the EAS sensing antenna to

determine how many items are still active, and thus, how many items were not properly deactivated) (col. 4, lines 26+).

Latimer et al is silent with respect to a self-checkout system, and utilizing a second EAS detector, which is associated with a bagwell/security scale of the checkout.

Bellis, Jr. et al teaches a self checkout system having one or more EAS monitors 300 disposed at the bagwell/security scale 290 area (see fig. 1; col. 3, lines 37-51), wherein the customer 330 is prompted to rescan the item if the EAS monitors 300 determine that the item includes an active EAS tag (col. 9, lines 15-24).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to utilize the system of Latimer et al as a self checkout system as taught by Bellis, Jr. et al for intended use. Furthermore, such modification would enhance the security system of Latimer et al (i.e., disposing a second EAS detector in the bagging/security area for detecting any active EAS tag, thus preventing unauthorized/unpaid items from unintentionally or intentionally taken out of the store); the operator/customer does not have to pass the scanned items back across the EAS sensing antenna to determine how many item are still active, thus reducing time and labor.

Re claims 15-19: see discussion above regarding claims 1-12. Bellis, Jr. et al further discloses a checkout computer 260 includes, among other things, a processor 350, a secondary memory 380 for storing computer programs, instructions and data, etc. which causes the processor to allow scanning of an item for purchase, determine whether the item has an active EAS tag, and allow deactivation of the active EAS tag (fig. 3; col. 4, line 1 through col. 5, line 25).

7. Claims 13-14 and 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Latimer et al as modified by Bellis, Jr. et al as applied to claims 8 and 15 above, and further in view of Garber et al (US 6,486,780 B1). The teachings of Latimer et al as modified by Bellis, Jr. et al have been discussed above.

Re claims 13-14 and 20: Latimer et al/Bellis, Jr. et al has been discussed above but is silent with respect to the electronic article surveillance detector comprising a coil and electronic circuitry/logic that is operative to obtain a signal from the coil indicative of the active electronic article surveillance tag.

Garber et al teaches an electronic article surveillance detector system comprising a coil/an antenna 104, a circuitry/an interrogation source 102 and a detector 106 for obtaining a signal from the coil indicative of the active electronic article surveillance tag (col. 7, lines 3+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ a coil and electronic circuitry/logic as taught by Garber et al into the electronic article surveillance detector of Latimer et al/Bellis, Jr. et al due to the fact that such modification would have been an obvious engineering design variation in an interrogation system, well within the ordinary skill in the art, for transmitting an interrogating signal to a transponder/surveillance tag that affixed to an article/item and for receiving a response signal from the tag, which would determine the presence of the tag, and therefore an obvious extension.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Swartz et al (US 6837436 B2); Mason (US 6497361 B1); Brenhouse (US 20020123932 A1) are cited as of interest and illustrate a similar structure to automatic electronic article surveillance for self-checkout.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can

normally be reached on First Monday 5:30AM-1:30PM and Tues-Fri 5:30AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Uyen-Chau N. Le
Examiner
Art Unit 2876

December 16, 2005